

## **REMARKS**

### **Introduction**

Claims 1-24 are pending in the application. Claims 1-24 are rejected. Claims 25-29 have been added. Claim 22 was objected to because it did not end with a period and is currently amended to end with a period. The proposed drawing correction filed on January 23, 2003 was approved, and corrected drawings are submitted herewith under a separate cover letter. For the reasons discussed in detail below, all of the pending claims are in condition for allowance.

### **Prior Art Rejections**

The Examiner has rejected claims 1-24 under 35 U.S.C. § 103(a) over U.S. Patent No. 5,930,474 to Dunworth et al ("Dunworth") and U.S. Patent 6,408,294 to Getchius et al ("Getchius"). Applicants respectfully traverse these rejections. In the following, applicants provide an overview of their invention and then discuss the differences with Dunworth and Getchius.

Applicant's technique is generally directed towards maintaining information in the form of location bindings for a merchant that identify one or more regions serviced by the merchant, beyond only that region in which the merchant has a physical presence. For example, instead of maintaining a single ZIP code that corresponds to the merchant's address, a number of ZIP codes that the merchant services may also be maintained in association with the merchant, so that the merchant will be identified in response to a search request

external to the merchant's ZIP code, but in a ZIP code serviced by the merchant as identified by the location bindings. Other aspects of the present invention are directed towards submitting a query for a merchant in a designated region, and receiving a business listing identifying a merchant that is not in the designated region, along with an explanation (such as text or glyph based) as to why that merchant was identified, e.g., the merchant services the region even though the merchant does not have a physical location in the region. Note that the above description is for example and informational purposes only, and should not be used to interpret the claims, which are discussed below.

In contrast to the claims of the present invention, Dunworth teaches that a topic and geographic area are searched, and to locate a business, the business must have a physical presence within the geographic area. The geographic areas can expand in a hierarchical manner, that is, an intermediate geographic area that includes a smaller geographic area can be searched, as can a larger geographic area that includes the intermediate geographic area (and thus the smaller geographic area). Dunworth, column 3, lines 46-54. However, as conceded in the Office action, Dunworth fails to disclose the concept of maintaining information that allows a business to be located when that business that does not have a physical location within a geographic area specified in a request. Instead, to locate such a business, Dunworth teaches that the database needs to search an expanded area by having the user manually ascend in the hierarchy (Dunworth, column 9, lines 1-4) until the geographic area specified in the request actually encompasses the physical location of the business. To this

extent, Dunworth teaches away from the present invention, in which in effect, the location bindings automatically extend the search region beyond that actually specified.

Notwithstanding the fact that Dunworth teaches manually expanding and contracting the geographic search area, which requires significant user interaction, (as opposed to providing some teaching or suggestion as to how a business can be located in a search when it does not physically reside within a specified geographic area), the Office action contends that Getchius, which teaches a virtual business that need not have a particular physical location, can somehow be combined with Dunworth to reach the claims of the present invention. Applicants strongly disagree with this contention.

In fact, even if true that Getchius teaches that a virtual business need not have a particular physical location, the allegation that the present invention is somehow obvious because of this is not reasonably supported by the prior art, and in general does not logically follow for a number of significant reasons. For one, the prior art of record does not disclose or suggest any apparent way to modify Dunworth to accommodate a virtual business, either explicit or otherwise. In fact, the prior art of record is silent as to such a concept, let alone how this might be accomplished, or why it might be desirable to do so.

For another, such a suggestion is counterintuitive, as such a combination would generally frustrate the very purpose of Dunworth, which is expressly geographic, and not topical, in nature. Dunworth, column 5, lines 60-65. By way of example, assuming that the Office action's alleged modification / combination

was possible, to include virtual businesses along with those in the geographic area of Dunworth, any virtual business that had no physical location would have to be returned in every search in Dunworth's system, making the geographic area specified by the user useless for many searches. In fact, for many searches the specifying of a request directed to a desired region would be pointless, since a large number of virtual businesses would be returned with the Office actions' proposed modification; (using the Office action's example, Amazon.com and every similar online retailer would be returned for any search in which the topic criterion was also met, even though the user expressly specified a geographic area). Thus, any such proposed modification would render the Dunworth et al. reference unsatisfactory for its intended purpose, and accordingly, the suggested modification is impermissible. See MPEP § 2143.01.

Further, the claims (e.g., independent claims 1, 8, 12 and 20) generally recite that "location binding information" is maintained in association with a merchant. However, in rejecting these claims, the Office action uses the example of Amazon.com as an example of a virtual business that would be returned for a search, regardless of the user having specifically provided a desired region. To do this with the present invention, Amazon.com would have to have a location binding (e.g., ZIP code) for every location in which it wanted to be returned in a search, which is of course highly impractical, and certainly not taught or suggested by Dunworth and/or Getchius. Instead, the present invention essentially teaches the use of actual location bindings that automatically expand a search beyond the criteria that the user has actually

requested, yet only when there is an actual match with a location binding. The Office action does not provide any information as to how the virtual business of Getchius might possibly accomplish such a task, except to broadly allege without support that Dunworth could be somehow modified to do this for virtual businesses that have no physical location.

By law, in order to establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In addition, "all words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Further, if prior art, in any material respect teaches away from the claimed invention, the art cannot be used to support an obviousness rejection. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed Cir. 1997).

Neither Dunworth nor Getchius, whether considered alone or in any permissible combination, teach the limitations of maintaining location binding information associating a merchant with a plurality of identified regions, and/or using that location binding information in a search that specifies a desired region, to see if there is a match, as generally recited in independent claims 1, 8, 12 and 20. Further, as recognized in the Office action, Dunworth has no facility for businesses that have no physical location in a region, and instead Dunworth teaches that the only way to locate such a business is to expand the geographic area that is searched to a size in which the business has a presence, which teaches away from the concept of automatically expanding a requested search

region via location bindings, as effectively accomplished by the present invention. Applicants further submit that claim 15 is thus patentable over Dunworth and/or Getchius for similar reasons, e.g., Dunworth cannot be permissibly modified by or combined with Getchius in a manner that allows a merchant to be identified when that merchant is not in the specified geographic area. For at least the foregoing reasons, each of the claims are patentable over the prior art of record as a matter of law. Reconsideration and withdrawal of the §103(a) rejections are respectfully requested.

Further, as a matter of law, obviousness may not be established using hindsight obtained in view of the teachings or suggestions of the applicants. *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). To guard against the use of such impermissible hindsight, obviousness needs to be determined by ascertaining whether the applicable prior art contains any suggestion or motivation for making the modifications in the design of the prior art article in order to produce the claimed design. The mere possibility that a prior art teaching could be modified such that its use would lead to the particular limitations recited in a claim does not make the recited limitation obvious, unless the prior art suggests the desirability of such a modification. See *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

In the present case, the prior art is silent as to such a modification / combination, which if somehow made would mostly be pointless and defeat Dunworth's geographic-based searching, as discussed above. Indeed, this is

evident from the Office action's alleged motivation, which is solely based on applicants' teachings, (albeit only partially), and not on anything found in the prior art of record or elsewhere. Note that applicants generally teach including a merchant that does not have a physical location in a search result set, such as by the use of location bindings that actually match a user-provided region, not simply including virtual businesses that do not have physical locations, as the Office action is attempting to find via Getchius.

Instead of finding some proper motivation to combine, the Office action makes mere conclusory statements, generally directed to including virtual businesses in geographic search results, that are counterintuitive and simply not supported by the prior art. Such mere, conclusory statements do not come close to adequately addressing the issue of motivation to combine, are not evidence of obviousness, and therefore are improper as a matter of law. *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

It appears that the Office action selected Dunworth, which generally refers to geographic searching, and even though it teaches away from the concept of location bindings, attempted to fill in the missing claim limitations with a reference (Getchius) that only generally teaches the concept of a virtual business, when in fact including purely virtual businesses in a result set (as alleged in the Office action) would essentially defeat Dunworth's geographic-based search. Thus, in the present case, it is clearly evident that the Office can only have located Dunworth and Getchius via impermissible hindsight gleaned from applicants' own teachings, and thereafter made a (failed) attempt to fit the prior art's teachings

into applicants' invention, even though neither teach or suggest location binding information to expand a search region, (and which Dunworth essentially teaches away from, as discussed above).

For at least these additional reasons, applicants submit that the claims are patentable over the prior art of record, whether considered alone or in any permissible combination, and respectfully request reconsideration and withdrawal of the rejections based thereon.

### **Objections**

Claim 22 was objected to because it did not end with a period. Claim 22 is currently amended to end with a period, thus overcoming the objection, and is in condition for allowance.



**Conclusion**

Based upon the above remarks, all of the pending claims are in condition for allowance. Applicant respectfully requests reconsideration of this application and its early allowance. If in the opinion of the Examiner a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney at (425) 836-3030.

Respectfully submitted,



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